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EXAMINER

YIP, WINNIE S

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/597,318
Filing Date: June 19, 2000
Appellant(s): VENEGAS, FRANK

MAILED

JAN 23 2008

GROUP 3600

John G. Posa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 19, 2007 appealing from the Office action mailed July 16, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

NEW GROUND(S) OF REJECTION

Claims 9-10 are added to the rejections under 35 U.S.C. 103 (a) as being unpatentable over US Patent No. 4,516,756 to Beatty in view of US Patent No. 5,299,883 to Arth, Jr. as discussed below.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

The Ground of rejections to claims 8-11 under 35 U.S.C. 103(a) as being unpatentable over US Patent No 5,299,883 to Arth, Jr. in view of US Patent No. 2,450,345 to Kervin.

The Ground of rejection to claim 8-11 under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 3,812,279 to Voegeli.

The ground of rejection to claim 12 under 35 U.S.C. 103 (a) as being unpatentable over Arth, Jr. in view of Kervin, or over Voegeli and further in view of US patent No. 3,319,328 to Finger et al.

GROUND OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

Claim 8 as being provisionally rejected under the judicially created doctrine of double patenting over claims 35 and 38 of copending Application No. 10/827,975.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,516,756	Beatty	03-1985
5,299,883	Arth, Jr.	04-1994
3,319,328	Finger et al.	05/1967

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

A. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,516,756 to Beatty '756 in view of U.S. Patent No. 5,299, 883 to Arth, Jr.

Regard to claims 8 and 11, Beatty shows and discloses a cover for covering a post (12 or 20), the cover consisting of an elongated, uniform and smooth cylindrical plastic sleeve (10, 14, or 18) with variety configurations such as may be a cylindrical sleeve (i.e., 18, Fig. 3) for matching with the configuration of the post to be covered, the sleeve (18) having an open lower end, and a closed upper end with variety of shapes, the sleeve (18) having an interior diameter and a consistent wall thickness including the closed upper end. Beatty further teaches the plastic sleeve being made of molded plastic having a durable coloring pigment throughout for providing a cover having color without coating or painting. Although Beatty does not explicitly define the sleeve having the interior diameter about 3 to 8 inches as claimed invention, Beatty had disclosed the cover (18) being used for slipped covering the variety different dimension posts for fence (see col. 1, line 48), and the fence post generally, as known in the art, has a 4x4 or 8x8 square inches cross section with a width of 4 or 8 inches. Since both covers of Beatty and

the claimed invention are used in the same field, it would have been obvious to one ordinary skill in the art at the time the invention was made to provide the interior diameter of the sleeve of the cover of Beatty having variety dimensions of about 3 to 8 inches as claimed because to do so would merely involve a matter of obvious design choice for the purpose of providing a cover having a diameter that can accommodate with various dimensional posts to be covered, and it appears that the claimed invention would perform equally well with the sleeve formed with a preselected diameter in the range of 3 to 8 inches as claimed to achieve the desirable result of covering variety of different dimensioned posts for custom needs. And, a change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

And, although Beatty does not specifically define the closed upper end of the sleeve of the cover specifically having a hemispherical shape as claimed, however, Beatty discloses the cover (10, 18) may have variety inner dimensions and variety shapes of upper end to accommodate the shaped of post to be covered (see Figs. 1-3), and the cover is used to cover “roughly hewn post” that may with roughly shaped upper end to provide a smooth surface for safety reasons and present a pleasing appearance (see col. 1, lines 35-40). And, Arth, Jr. teaches a protective cover (14) for covering a post (16), the cover (14) consisting of an elongated sleeve (18) having a closed and hemispherical shaped upper end (20) for providing a deformable and cushionable protection over the post and providing obvious variations of pleasing appearances that solves a same problem as the claimed invention (see col. 1, lines 55-60). Arth, Jr. teaches the protective cover having an elongated generally cylindrical plastic sleeve with a flexible locking lip for preventing the cover being lifted to solve a problem when the cover without the

locking lip. On the other hand, Arth, Jr. disclosed a cover having an elongated and consistent wall thickness without a locking lip is old and known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cover of Beatty having the closed upper end of the sleeve being formed with a desirable shape specifically in a hemispherical shape as taught by Arth, Jr. for providing a deformable and cushionable protection over the post and providing a printed and smooth surface with obvious variations of pleasing appearances to accommodate the custom need since the applicant has not disclosed that the specific shape of the closed upper end and the specific diameter of interior of a cover solve any stated problem or is for any particular purpose and it appears that the claimed invention would perform equally well with the upper end of the sleeve having a hemispherical shape to cover the post with a preselected appearance and a cushionable feel for protecting attachment from a person's hand. And, a change in size and shape is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ237 (CCPA 1955).

In regard to claims 9-10, Although Beatty does not specifically define what specific type of plastic material that the cover is made. However, Arth, Jr. discloses a cover comprising an elongated sleeve being made of plastic such as polyethylene (see col. 3, line 29). It would have been obvious to one skilled in the art at the time the invention was made to modify the cover of Beatty being made of polymeric plastic especially of polyethylene or polycarbonate as taught by Arth, Jr. for forming a cover having advantage of the polymeric plastic's desirable properties such as having sufficient impact strength characterizes, corrosion and wear properties such as thermal expansion, moisture absorption and resistance to chemical attack to allow it being used outdoor with environmental protection.

All of the foregoing is within the skills, competence and knowledge of the person with ordinary skills in the covering art.

B. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,516,756 to Beatty in view U.S. Patent No. 5,299,883 to Arth, Jr. as applied to claim 8 above, and further in view of U.S. Patent No. 3,319,328 to Finger et al.

Beatty as modified by Arth, Jr. teaches all structural limitations as claimed as explained and applied above rejections except that Beatty does not specifically define what specific type of plastic material including an additive to resist ultraviolet deterioration. Finger et al. teach a cover for covering a post, the cover consisting of an elongated sleeve (27) being made of plastic such as polyethylene being treated by coating dipping or spraying or given a treatment with an additive of an ozone resistant material for resisting ultra violet deterioration. (see col. 5, lines 15-17). And, it is a common known that a colored plastic generally resisting suitable Ultra violet lighting. It would have been obvious to one skilled in the art at the time the invention was made to modify the cover of Beatty as modified by Arth, Jr. being made of polymeric plastic as choice of material with suitable treatment of an additive to resist the ultraviolet deterioration as taught by Finger et al. for all type of exposed posts having terminal areas subject to infiltration of harmful elements as well as a deterioration due to exposure to weather and temperature condition.

(10) Response to Argument

First, Appellant's arguments with respect to claims 8-11 as being rejected under U.S.C. 103 (a) as being unpatentably over Arth, Jr. '883 in view of Kervin '345, or over Voegeli are moot in view of the grounds being withdrawn.

Second, Appellant argues that is not obvious to make the top of the post cover in Beatty hemispherical because Beatty discloses tops which conform to the top of the post and there is no hemispherically-topped post disclosed in Beatty. While it is true that Beatty does not specifically disclose a cover that has "hemispherically shaped upper end" as claimed, the rejection was based upon Beatty in view of Arth Jr. not Beatty alone. As appellant admits Beatty, discloses a cover that conforms to the top of the post on which it used and Beatty does disclose using the cover on many different types of posts (as shown in Fig. 3). Beatty discloses that the cover having an enclosed upper end may be formed with suitable shapes for covering the post which is unpainted, roughly hewn wood picket (or wooden post), wherein the post may have a rough upper end with different shape such as flatted (12) or pointed (12). Therefore, Beatty suggests that the cover can be shaped to cover many types of posts. Arth, Jr. teaches that post covers are know to have hemispherically topped ends. Therefore, one of ordinary skill in the art, would have modified the post cover of Beatty to alternatively have a hemispherically shaped top end as taught by Arth, Jr. as an obvious matter of design choice to obtain a cover with a desirable shaped upper end as a custom's choice, to accommodate the shape of the post being covered for protecting penetration of the post through the sleeve or to obtain a desirable aesthetic appearance, and the result is reasonably predictable.

Third, Appellant argues that Arth, Jr. has additional features of an interlocking lip not required by Applicant's invention is irrelevant. Arth, Jr.'s description of improved protective cover having an elongated generally cylindrical plastic sleeve with a flexible locking lip for preventing the cover being lifted from a post does not "teach away" from of a sleeve with a hemispherical end top for a normal purpose of cover when the lip is not desired. Accordingly, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement

Finally, Appellant argues regarding claim 12, that there is no motivation to combine all of the reference because the references teach much more appellant's "consisting of" claim. This argument is not persuasive. Claim 8 directly claims the cover consisting of an elongated, generally cylindrical plastic sleeve", however claim 12 claims the plastic cover further including "an additive". Beatty's cover as modified by Arth, Jr. is considered to have a "consisting" structural limitations as well as claimed, and the patent to Finger et al. is considered to teach a plastic sleeve may be formed with a plastic material which may formed with additional "an additive" by a suitable method as formed by a given treatment. No additional structural limitation is added. Therefore, the motivation to combine the references is obvious established.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

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Art Unit: 3636

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Respectfully submitted,

/Winnie Yip/
Primary Examiner, Art Unit 3636

January 10, 2008


A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:

Petravick, Meredith /mcp/

Dunn, David

DD


WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR